

**REMARKS**

Claims 1, 2, 4 and 7-23 are currently pending in the application. Claims 11-18, 20, and 21 were withdrawn from consideration by the Examiner as being directed to a non-elected invention. By this response, no claims are amended, added, or canceled. Reconsideration of the rejected claims in view of the above amendments and the following remarks is respectfully requested.

***Withdrawn claims***

The Examiner withdrew claims 11-18, 20, and 21 from consideration as being directed to a non-elected invention. The Examiner contends that independent claims 11, 16, and 20 do not include all of the technical features set forth in claim 1.

Applicants do not agree with the restriction requirement and are not canceling the withdrawn claims at this time. Under 37 C.F.R. 1.144, a petition from a requirement for restriction may be deferred until after final action, and can be filed no later than appeal. Cancellation of claims 11-18, 20, and 21 in this response would prematurely extinguish this right to petition. Thus, in order to preserve the right to petition, Applicants are not canceling the withdrawn claims at this time.

Applicants submit that the remarks below place the application in condition for allowance by addressing and traversing all of the rejections set forth in the outstanding Final Office Action. Thus, this response is a complete reply to the outstanding Final Office Action. MPEP 821.01 sets forth that where a reply to a final action has otherwise placed the application in condition for allowance, the failure to cancel claims drawn to the nonelected invention(s) not eligible for rejoinder or to take appropriate action will be construed as authorization to cancel these claims by

examiner's amendment and pass the application to issue after the expiration of the period for reply.

### 35 U.S.C. §103 Rejection

Claims 1, 2, 4, 7-10, 19, 22, and 23 are rejected under 35 U.S.C. §103(a) for being unpatentable over U.S. Pat. No. 5,098,762 issued to Nakajima ("Nakajima") in view of U.S. Pat. No. 6,696,167 issued to Sean *et al.* ("Sean") and either of DE 2606666 or U.S. Pat. No. 6,625,943 issued to Renner ("Renner"). This rejection is respectfully traversed.

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness. See MPEP §2142. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.<sup>1</sup> Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Applicants submit that no proper combination of the applied art teaches or suggests each and every feature of the claimed invention.

<sup>1</sup> While the *KSR* court rejected a rigid application of the teaching, suggestion, or motivation ("TSM") test in an obviousness inquiry, the [Supreme] Court acknowledged the importance of identifying "a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does" in an obviousness determination. *Takeda Chemical Industries, Ltd. v. Alphapharm Pty., Ltd.*, 492 F.3d 1350, 1356-1357 (Fed. Cir. 2007) (quoting *KSR International Co. v. Teleflex Inc.*, --- U.S. ---, 127 S.Ct. 1727, 1731 (2007)).

As previously discussed, such that further elaboration is not believed necessary, the present invention relates to a building board for use as a ceiling or wall element. Independent claim 1 recites, in pertinent part, *a plurality of orientated strand boards (OSBs) which are disposed side by side and are bonded together in multiple layers ... and at least one nail plate disposed between respectively two layers lying one on top of the other*. Applicants respectfully submit that the applied references fail to disclose or suggest a nail plate disposed between layers of boards disposed side by side and bonded together.

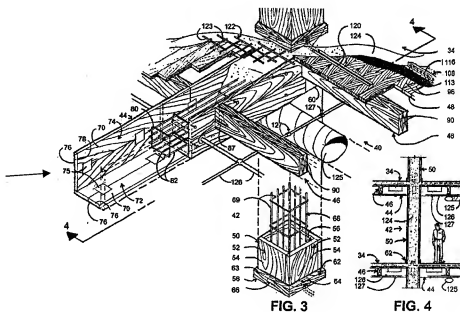
The Examiner asserts that Nakajima discloses a plurality of boards disposed side by side and bonded together to form multiple layers. The Examiner also contends that Sean teaches equivalence between wood and OSB boards, and that it would have been obvious to use OSB boards in Nakajima in view of Sean. The Examiner is further of the opinion that DE 2606666 and Renner each disclose the structural equivalence of the use of nail plates and adhesives in bonding boards together. The Examiner concludes that it would have been obvious to use nail plates between the layers of Nakajima boards in order to provide a strong joint between the individual layers. Applicants respectfully disagree with the conclusion of obviousness, and submit that the applied references fail to disclose or suggest all of the features of the claimed invention.

Neither Nakajima nor Sean discloses a nail plate. For example, Nakajima shows multiple boards bonded together to form layers; however, Nakajima only discloses that the layers are adhered together (column 2, line 1). Sean does not disclose a plurality of boards bonded together in layers, and consequently does not disclose any structure for bonding layers together. Therefore, neither Nakajima nor Sean discloses or suggests at least one nail plate disposed between respectively two layers lying one on top of the other, as recited in claim 1.

DE 2606666 and Renner do not compensate for the deficiencies of Nakajima and Renner with respect to independent claim 1. That is, neither DE 2606666 nor Renner discloses *at least one nail plate disposed between respectively two layers lying one on top of the other*, as recited in claim 1.

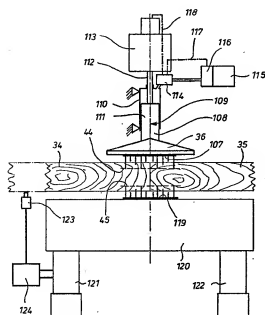
Instead, Renner discloses a building system in which a nail plate 75 spans a gap between two boards arranged end-to-end along longitudinal ends of the boards (e.g., a butt joint). However, the nail plate 75 is not disposed between two layers of boards lying one on top of the other, as shown in FIG. 3 of Renner reproduced below:

Nail plate 75 spans the longitudinal ends of two boards. However, the nail plate 75 is not disposed between two layers of boards lying one on top of the other.

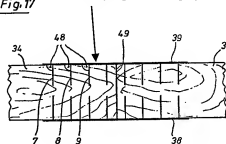
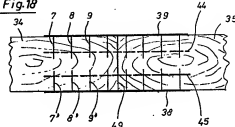


In contrast to Renner's nail plate 75, the nail plate of embodiments of the present invention is disposed between two layers of boards lying one on top of the other. That is, in Applicants' invention, the nail plate is sandwiched between two layers, as depicted in the Figure of Applicants' invention. Renner simply does not disclose or suggest that a nail plate can be arranged between two layers lying one on top of the other.

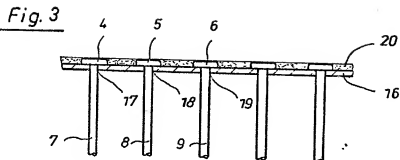
Similar to Renner, DE 2606666 discloses a nail plate used for fixing a butt joint in which two boards are attached end-to-end (see, e.g., FIGS. 15, 17, and 18, reproduced below). Again, this differs from the present invention in which a nail plate is disposed between two layers of boards lying one on top of the other. DE 260666 does not disclose or suggest that a nail plate can be arranged between two layers.

Fig.15

*The nail plate spans the transverse ends of two boards arranged end-to-end. However, the nail plate is not disposed between two layers of boards lying one on top of the other.*

Fig.17Fig.18

A specific embodiment of the nail plate of DE 2606666 is depicted in FIG. 3 of DE 2606666, reproduced below. Particularly, FIG. 3 shows a metal plate 16 having holes 17, 18, 19 in which nails 7, 8, 9 are held. The heads 4, 5, 6, of the respective nails 7, 8, 9 are held by layer 20, which can be metal or plastic. In this manner, a plurality of nails (7, 8, 9) may be pressed into two boards arranged end-to-end (e.g., in the operation depicted above in FIG. 15), to produce an end-to-end connection of the boards (e.g., as in FIGS. 17 and 18, shown above).



However, the nail plate in FIG. 3 of DE 2606666 is not disposed between two layers of side-by-side boards, as recited in the claimed invention. Instead, FIG. 3 of DE 2606666 shows only a nail plate (as evidenced by the machine translation of the paragraph of DE 2606666 that describes FIG. 3, in this footnote<sup>2</sup>), and does not show the nail plate applied between two layers of side-by-side boards.

Thus, both Renner and DE 2606666 disclose a nail plate used for connecting two boards joined end-to-end (Renner along the longitudinal ends, and DE 2606666 along the transverse ends). However, neither discloses or suggests a nail plate disposed between two layers of side-by-side boards. Therefore, none of the applied references discloses or suggests *a plurality of orientated strand boards (OSBs) which are disposed side by side and are bonded together in multiple layers ... and at least one nail plate disposed between respectively two layers lying one on top of the other*, as recited in claim 1.

The Examiner, in the Response to Arguments section of the Final Office Action, asserts that “[e]ven if these references were limited to joining boards end to end, one of ordinary skill in

<sup>2</sup> Machine translation of the third paragraph of page 23 of DE 2606666, provided by <http://babelfish.altavista.com/tr>:

After Fig. 3 is a metallic retaining plate 16 of denSehaef ten the nails 7 - 9 intersperses. The plate 16 having openings 17 - 19, in which the nails are led. On the side cleared away from the nail shanks are the heads 4 - 6, and they are fixed by a layer 20, which can consist either of a metal or also of a plastic, which specifies the heads at the plate 16. Here zuberUcksich is tigen the fact that during bringing in the nail plate an outside pressure plate on the heads 4 - works 6, so that the danger does not exist that a solution of the retaining plate takes place altogether.

the art would instantly recognize that the nail plates could be used to reinforce any type of butt joint whether it be end to end or otherwise.” Without acquiescing in the validity of this assertion, Applicants submit that the Examiner’s remarks do not address the language of the claimed invention. That is, the Examiner has failed to address Applicants’ previous arguments that the applied references fail to disclose or suggest a nail plate disposed between two layers of side-by-side boards.

Also, Applicants submit that the Examiner’s assertion is a mere conclusion, not supported by any references. For this reason, Applicants respectfully submit that the Examiner appears to be applying official notice. Applicants remind the Examiner that MPEP 2144.03 specifically explains that “[o]fficial notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known.” Applicants do not agree with the Examiner that the features of the claimed invention are instantly recognizable (e.g., common knowledge). As such, in accordance with MPEP 2144.03 Applicants respectfully traverse the assertion of official notice and request that the Examiner produce documentary evidence to support the Examiner’s assertions of official notice.

Moreover, as the applied art fails to disclose all of the features of the claims, Applicants submit that the rejection is necessarily based upon information that the Examiner gleaned only from Applicants’ disclosure. That is, notwithstanding the fact that none of the applied art even suggests a nail plate disposed between layers of side-by-side boards, the Examiner concludes that it would have been obvious to modify Nakajima to provide a nail plate between layers of Nakajima’s boards. This is a clear example of the Examiner using Applicants’ disclosure as a blueprint for formulating the rejection, which is an impermissible use of hindsight reasoning.

Claims 2, 4, 7-10, 19, 22, and 23 depend from independent claim 1, and are distinguishable from the applied art at least for the reasons discussed above with respect to claim 1. Moreover, the applied art fails to disclose or suggest many of the features additionally recited in these dependent claims.

Accordingly, Applicants respectfully request that the §103(a) rejection over claims 1, 2, 4, 7-10, 19, 22, and 23 be withdrawn.

### CONCLUSION

In view of the foregoing remarks, Applicants submit that all of the claims are patentably distinct from the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue. The Examiner is invited to contact the undersigned at the telephone number listed below, if needed. Applicants hereby make a written conditional petition for extension of time, if required. Please charge any deficiencies in fees and credit any overpayment of fees to Attorney's Deposit Account No. 19-0089.

Respectfully submitted,  
Joachim HASCH et al.



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